

SEP 06 2002

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
RESPONSE/AMENDMENT

Case Docket No. 7995

Box NON-FEE AMENDMENT
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Dear Sir:

Transmitted herewith is an AMENDMENT for the patent application:

Inventor(s): P. W. Hamilton et al. Confirmation No.
Serial No.: 09/532,576 Group Art Unit: 1772
Date Filed: March 22, 2000 Examiner: Alicia A. Chevalier
Title: HIGH BOND STRENGTH, REPOSITIONABLE ADHERENT SHEET

1. ☒ No additional fee is known to be required.
2. ☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA*	RATE	FEE
TOTAL	*	MINUS	**	=	x \$18 =	\$0
INDEP.	*	MINUS	***	=	x \$80 =	\$0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ \$270 =	\$0
					TOTAL	\$0

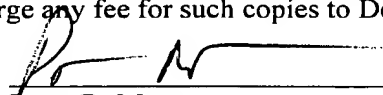
* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the highest number of total claims previously paid for is less than 20, write "20" in this space.

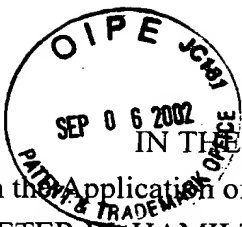
*** If the highest number of independent claims previously paid for is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

3. ☐ The Commissioner is hereby petitioned under 37 CFR §1.136(a) to grant any extension of time needed for timely response to the Office Action dated in the above-identified application to preserve pendency of said application. The processing fee under 37 CFR §1.17 has been determined as follows: \$ for a -month extension of time.
4. The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 16-2480. A duplicate copy of this sheet is attached.
 - a. ☒ Any patent application processing fees under 37 CFR §1.16.
 - b. ☒ Any patent application processing fees under 37 CFR §1.17.
5. The Commissioner is hereby authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to Deposit Account No. 16-2480.


Peter D. Meyer
Attorney for Applicant(s)
Registration No. 47,792
Tel. No. (513) 634-5649
Customer Number 27752

February 19, 2002



Case 7995

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
In the Application of
PETER W. HAMILTON, ET AL.

#10

Serial No. 09/532,576

Group Art Unit: 1772

Filed: March 22, 2000

Examiner: Alicia A. Chevalier

For: HIGH BOND STRENGTH, REPOSITIONABLE ADHERENT SHEET

RESPONSE TO RESTRICTION REQUIREMENT OF JANUARY 29, 2002

The Assistant Commissioner of Patents
Washington, DC 20231

Dear Sir:

This Response is timely filed pursuant to the provisions of 37 C.F.R. § 1.8 and M.P.E.P §512.

35 U.S.C. §121 Restriction Requirement

The Examiner has required restriction as to Claims 1-57 (Group I), Claim 58, (Group II), and Claims 59-62 (Group III) because the inventions are distinct. Applicants elect Claims 1-57 (Group I) with traverse.

The Examiner's attention is directed to Claim 59. Claim 59 is dependant upon Applicants' Claim 1. The Examiner states that Claims 59-62 (Group III), as submitted, are drawn to an invention that is independent or distinct from Claims 1-57 (Group I).

Applicants respectfully direct the Examiner to the following excerpt from MPEP § 821.04:

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. **Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of**

right if the amendment is presented prior to final rejection or allowance.
(Emphasis supplied)

Thus, Applicants respectfully submit that the Examiner's election/restriction requirement and the resulting withdrawal of Claims 59-62 (Group III), as presented, would be improper under current MPEP guidelines.

Applicants' also traverse the restriction requirement as being legally inconsistent with the decision of the Federal Circuit in *In re Ochai*, 71 F.3d 1565 (Fed. Cir. 1995). The court, in *Ochiai*, stated that method claims, limited to the use of a particular non-obvious starting material for making a particular non-obvious end product, are themselves patentable. *See* 71 F.3d 1565, 1572 (Fed. Cir. 1995). The court went further to say that an applicant is entitled to a patent unless it is established that the application is obvious over cited prior art. Applicants' Claims 1-57 (Group I) are drawn to a novel, and non-obvious adherant sheet material. Applicants' Claims 59-62 (Group III) are drawn to the method of use of the novel, and non-obvious, adherant sheet material of Claim 1 of Group I. Thus, Applicants respectfully submit that the Examiner's election/restriction requirement and the resulting withdrawal of Claims 59-62 (Group III), as presented, would be improper under current Federal Circuit law. Further, Applicants expressly reserve the right of petition in this matter.

Applicants traverse the restriction requirement of the Group II claims because the search and examination of the entire application can be made without serious burden. If the search and examination of an entire application can be made *without serious burden*, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. *See* M.P.E.P. § 803. In the instant application, Group I (product), Group II (method of making the product), and Group III (method of use of the product of Claim 1), are all drawn to an adherent sheet material. Thus, the Examiner would likely search Class 428, subclass 174, Class 427, subclass 207.1, and Class 150, subclass 60 for complete

examination of the product claims of Group I. Therefore, Applicants request the Examiner to reconsider and withdraw the restriction requirement for Group 1, containing Claims 1-57, Group II, containing Claim 58, and Group III, containing Claims 59-62.

Respectfully submitted,

HAMILTON, ET AL

By 

Peter D. Meyer

Attorney for Applicants

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February 19, 2002



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United States Patent and Trademark Office**

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Inventor(s): Hamilton et al.

S.N.: 09/532,576

Filed: March 22, 2000

Case: 7995

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